

POCKET NO.: 197484US0

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IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE APPLICATION OF

YASUO SUZUKI, ET AL.

SERIAL NO: 09/679,480

FILED: OCTOBER 5, 2000

FOR: ELECTROPHOTOGRAPHIC
PHOTORECEPTOR AND
ELECTROPHOTOGRAPHIC IMAGE
FORMING METHOD AND
APPARATUS USING THE
PHOTORECEPTOR

:

: EXAMINER: DOTE, J. L.

:

: GROUP ART UNIT: 1753

:

PETITION UNDER 37 C.F.R. § 1.181

ASSISTANT COMMISSIONER FOR PATENTS
WASHINGTON, D.C. 20231

SIR:

Petitioners respectfully submit that the Notice of Improper Request for Continued Examination issued by the Office on August 2, 2002 is improper, and respectfully request that it be withdrawn.

1. On January 8, 2002, the Office issued a Final Rejection in the above-identified application.
2. In response, Applicants filed a Request for Reconsideration under 37 C.F.R. §1.116, together with a terminal disclaimer, and the fee for a one-month extension of time on April 8, 2002. As evidence thereof, Petitioners provide herewith a date-stamped filing receipt dated April 8, 2002.

3. On April 18, 2002, the Office then issued an Advisory Action, stating that "the request for reconsideration has been considered" but that "Applicants should explain why in



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the results in the specification differ from those in Suzuki.” As evidence thereof, Applicants enclose herewith the Advisory Action issued April 18, 2002.

4. On May 8, 2002, Applicants filed a Notice of Appeal, a request for a one-month extension of time, and the necessary fees. As evidence thereof, Applicants provide herewith a date-stamped filing receipt dated May 8, 2002.

5. On July 8, 2002, Applicants filed a Request for Continued Examination (RCE) together with a Declaration under 37 C.F.R. §1.132 comparing the results in the instant specification with those of Suzuki, and the required fees. As evidence thereof, Applicants provide herewith a date-stamped filing receipt dated July 8, 2002.

6. On August 2, 2002, the Office issued a Notice of Improper Request for Continued Examination, enclosed herewith, indicating that the RCE was “not accompanied by a submission as required by 37 C.F.R. §1.114.”

7. 37 C.F.R. §1.114(a) states that “[i]f prosecution in an application is closed, an applicant may request continued examination of the application by filing a submission and the fees set forth in § 1.17(e).” 37 C.F.R. §1.114(c) states that a submission “includes, but is not limited to, an information disclosure statement, an amendment to the written description, claims or drawings, new arguments, or new evidence in support of patentability. If reply to an Office Action under 35 U.S.C. 132 is outstanding, the submission must meet the reply requirements of § 1.111.”

8. As discussed above, Applicants’ Request for Reconsideration filed April 8, 2002, was considered by the Examiner, as indicated in the Advisory Action issued April 18, 2002. Thus, there is no outstanding reply to an Office Action under 35 U.S.C. §132, and therefore, a “submission” under 37 C.F.R. §1.114 need not comply with the requirements of 37 C.F.R. §1.111.

9. As stated in 37 C.F.R. §1.114(c), a proper submission includes "new evidence in support of patentability." Applicants respectfully submit that the Declaration under 37 C.F.R. §1.132 filed with the RCE on July 8, 2002 is "new evidence in support of patentability." Thus, the Declaration under 37 C.F.R. §1.132 filed with the RCE on July 8, 2002 is a "submission" in compliance with 37 C.F.R. §1.114(c), and therefore the RCE filed on July 8, 2002, was, in fact, filed with a proper submission.

Accordingly, Applicants respectfully submit that the Notice of Improper Request for Continued Examination is itself improper, and should be withdrawn. Applicants therefore request entry and consideration of the Request for Continued Examination under 37 C.F.R. §1.114, and the Declaration under 37 C.F.R. §1.132.

Respectfully submitted,

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